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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,109	12/30/1999	MASAHICO HIROSE		4688

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/462,109

Applicant(s)

HIROSE ET AL.

Examiner

Victor S Chang

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 2, 5, 18, 19.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700



NOTE

1. With respect to Mr. Hirose's Declaration, the Examiner notes that it is untimely to submit Declaration after Final, and normally would not be entered. However, the Examiner has entered the Declaration in order to expedite possible future prosecution.
2. With respect to Applicant's argument that "increasing the amount of NaCl in the solution and increasing the operation pressure necessarily have the effect of increasing the salt rejection" (Response, page 4, second complete paragraph), the Examiner notes that Applicant has not pointed out any express or inherent support of the aforementioned relation between operation pressure and salt rejection in the specification, nor does the Examiner find the relation being inherent, i.e., further evidentiary support is necessary.
3. It is noted that Mr. Hirose's Declaration appears to raise new issues which would require further consideration and/or search. In particular, it lacks a direct comparison of results under the same test conditions. If further prosecution, i.e., a CPA or RCE, is contemplated, the Examiner would like to strongly urge Applicants further provide either evidentiary support for the relation between operation pressure and salt rejection as set forth above, or test results of the instant invention under the same test conditions as in the Example 1 of Ikeda et al. (US 5178766),
4. Applicant's hypothesis appears to argue that the instant invention has higher hydrophilicity than Ikeda's membrane due to greater amount of amide linkages and/or carboxylic groups (Response, pages 3-4, bridging paragraph), however, such element

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is absent from the independent claim 1, and it also appears to be either inherently disclosed, or an obvious optimization to one skilled in the art of polyamide reverse osmosis membrane, motivated by the desire to obtain improved wetting (i.e., lower contact angle) between the polyamide layer surface and water (see Paper No. 18, pages 6-7, bridging paragraph).

5. With respect to Applicant's argument that "Hirose only qualifies as prior art under 102(e), ... the common ownership exception provided by 35 U.S.S. 103(c) controls", the Examiner notes that the rejection over Hirose (US 6171497) has already been withdrawn in prior Office action (see Paper No. 21).